

REMARKS

The Office Action of June 4, 2004 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 1-61 remain pending. Claims 1-3, 20-22, 31-33, 37-39, 46, 48, 51-53, and 56-57 have been amended. No new matter has been added.

Office Action Deficiencies

With respect to claim 18, the Applicant respectfully submits that it is in condition for allowance as no rejection or argument was made regarding its subject matter. While claim 18 was listed as rejected in the Office Action Summary, the body of the Office Action contained no substantive rejection of claim 18, and thus Applicant has no fair opportunity to respond.

With respect to claims 12 and 19, the Office Action states that the claims are rejected under §102(e). Office Action, ¶ 3. However, the arguments made against claims 12 and 19 are presented in the section containing rejections under §103(a). Office Action, ¶ 5. Therefore, Applicant respectfully submits that there is no fair opportunity to respond since it is unclear whether claims 12 and 19 are rejected under § 102 or § 103.

Claim Rejections

Rejections Under 35 U.S.C. § 102

Claims 1, 3, 7-13, 17, 19, 20, 22, 26-31, 33-37, 39 and 42-45 are rejected under 35 U.S.C. §102(e) as being anticipated by Henrick (U.S. Patent No. 6,507,727) (Note comment re claims 12 and 19, above). This rejection is respectfully traversed.

Amended independent claim 1 recites, *inter alia*, “(iii) the content server receiving a second request for a specific content item from the mobile unit via the transceiver; and (iv) transmitting a second response from the content server to the mobile unit via the transceiver, wherein the second response comprises accessibility data corresponding to the specific content item, wherein the mobile unit accesses the content item using said accessibility data.” However, Henrick does not teach or suggest such a feature. At most, Henrick teaches the Web server generating a screen with information such as an identity of a song, album, and artist.

Information such as the identity of a song, album and/or artist is not at all similar to accessibility data corresponding to a specific content item, wherein the mobile unit uses the accessibility data to access the specific content item. Henrick does not teach a mobile unit both requesting a specific content item and accessing the specific content item. Henrick specifically teaches away from such a feature, stating that a user identifies a second device to which the requested content is to be downloaded. Col. 5, ll. 11-24. As such, claim 1 is allowable for at least this reason.

Claims 3, 7-13, 17 and 19 are dependent on claim 1 and are thus allowable for at least the same reasons as claim 1.

In addition, amended dependent claim 3 recites, *inter alia*, “the accessibility data comprises the specific content item.” Henrick does not teach or suggest such a feature. In fact, Henrick teaches away from such a method by stating that the specific content item is downloaded to a second device (e.g., other than the mobile unit with which the request was made). Col. 5, ll. 8-46. Nowhere does Henrick suggest that the specific content item is sent to the mobile unit with which the request was made. As such, claim 3 is allowable for this additional reason.

Amended independent claim 20 recites, *inter alia*, “(iii) receiving a second request for a specific content item from the mobile unit via the transceiver; and (iv) transmitting a second response to the mobile unit via the transceiver, wherein the second response comprises accessibility data corresponding to the specific content item, wherein the mobile unit accesses the content item using said accessibility data.” Similar to the arguments made in claim 1, Henrick does not teach or suggest such a feature, and claim 20 is thus allowable for similar reasons as claim 1.

Claims 22 and 26-30 are dependent on claim 20 and are thus allowable for at least the same reasons as claim 20.

Additionally, amended dependent claim 22 recites, *inter alia*, “the accessibility data comprises the specific content item.” As with claim 3, Henrick does not teach or even suggest such a feature. As such, claim 22 is allowable for this additional reason.

Amended independent claim 31 recites, *inter alia*, “(iii) receiving a second request for a specific content item from the mobile unit via the transceiver; and (iv) transmitting a second response to the mobile unit via the transceiver, wherein the second response comprises

accessibility data corresponding to the specific content item, wherein the mobile unit accesses the content item using said accessibility data.” For reasons similar to those previously mentioned in claims 1 and 20, Applicant respectfully submits that Henrick does not teach or suggest such a feature. As such, claim 31 is allowable for at least this reason.

Claims 33-36 are dependent on claim 31 and are thus allowable for at least the same reasons as claim 31.

Additionally, amended dependent claim 33 recites, *inter alia*, “the accessibility data comprises the specific content item.” As with claims 3 and 22, Henrick does not teach or suggest such a feature. As such, claim 33 is allowable for this additional reason.

Amended independent claim 37 recites, *inter alia*, “(iii) sending a second request for a specific content item to the content server; and (iv) receiving a second response from the content server via the transceiver, wherein the second response comprises accessibility data corresponding to the specific content item, wherein the mobile unit accesses the content item using said accessibility data.” As noted above with respect to claims 1, 20, and 31, Henrick fails to suggest a mobile unit both requesting and accessing a specific content item. Claim 37 is thus allowable for at least this reason.

Claims 39 and 42-45 are dependent on claim 37 and are thus allowable for at least the same reasons as claim 37.

Additionally, claim 39 recites, *inter alia*, “the accessibility data comprises the specific content item.” As with claims 3, 22, and 33, Henrick does not teach or even suggest such a feature. As such, claim 39 is allowable for this additional reason.

Rejections Under 35 U.S.C. § 103

Claims 1, 2, 14-16, 21 and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wegener *et al.* (U.S. Patent No. 6,490,432) (hereinafter “Wegener”) in view of Henrick. This rejection is respectfully traversed.

Wegener generally relates to a service for delivering media on-demand. More specifically, Wegener teaches a service for storing portions of content on both local and remote databases. Portions of content are downloaded to the local storage memory via a broadcast scheduler, which determines the order in which scheduled broadcast content portions from a

database are transmitted. Col. 5, ll. 29-41. Locally stored content includes one or more links to additional or related remotely stored content so users may access remotely stored portions of content. Col. 6, ll. 19-48. Even so, the suggested combination of Wegener and Henrick lacks the required motivation to combine the references in the first place.

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 U.S.P.Q.2d 1788 (Bd. Pat. App. & Inter. 1986). The Examiner has failed to provide such an explanation. The Examiner states that it would have been obvious to one of ordinary skill in the art at the time of the invention to use content distribution in a short range environment in order to save power and take advantage of the proliferation of available short range networks. Office Action, ¶ 5. In short, the Examiner is asserting that the combination would be obvious in view of the Applicant's invention, and such a motivation constitutes impermissible hindsight. That is, the Examiner's alleged motivation to combine the references is actually a result of the combination, not a motivation to combine them in the first place. Additionally, it would not have been desirable to combine the on-demand video and audio system of Wegener with the content delivery method of Henrick. The method described in Henrick is limited to requesting and receiving audio or video already playing at the time of the user request. Wegener, on the other hand, discloses on-demand audio and video which permits users to request and retrieve video or audio at any time (i.e., on-demand), even when that particular audio or video content item is not playing. Therefore, it would be illogical to combine the on-demand features of Wegener with the limited retrieval method of Henrick. As such, all claims rejected under §103(a) as being unpatentable over Wegener in view of Henrick are allowable for at least this reason.

Claims 4-5, 23-24 and 40-41 are rejected under 35 U.S.C. §103(a) as being unpatentable over Henrick in view of Levy *et al.* (U.S. Patent No. 6,505,160) (hereinafter "Levy"). This rejection is respectfully traversed. Claims 4-5, 23-24 and 40-41 are allowable at least for the same reasons as their respective base claims because Levy does not cure the deficiencies of Henrick.

Levy describes a system of connected audio and other media objects which may contain identifiers embedded into the objects themselves or containers. These identifiers are then used to

link the media objects or audio to metadata and actions via a communications network. Col. 1, ll. 41-46. In one example, a marked MP3 object may contain embedded identifiers which, upon decoding, provide links to web pages that may contain further information about the song, artist or type of music. Col. 6, ll. 29-59. As discussed above, Henrick describes a system for downloading a presently playing audio or video file directly to a device other than a device from which the request for download was sent. The Office Action states that it would have been obvious to combine Henrick and Levy “in order to save power in short range communications with the additional advantage that the line of sight is not required.” However, as with the combination of Henrick and Wegener, this is not a motivation to combine the references, but is instead a result of a combination made through impermissible hindsight. Because there is no motivation to combine Henrick and Levy, this rejection is traversed.

Claims 6 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Henrick in view of Callway *et al.* (U.S. Patent Pub. No. US 2003/0027517) (hereinafter “Callway”). This rejection is respectfully traversed.

Callway generally relates to a wireless display apparatus and method for decompressing compressed video streams. See Abstract. More specifically, Callway seeks to replicate wireless peripheral technology (e.g., wireless mouse, wireless keyboard) to create a wireless display. P. 1, ¶ 3. As such, Applicant respectfully submits that Callway is not in an analogous art and therefore is not a proper reference to use as a basis for rejection under § 103.

In order to rely on a reference as basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). Callway fails to satisfy either condition. Callway is directed toward wireless display technology and not selective media capture through via a communications device. Whereas the Callway device is used to wirelessly transmit video signals to a display, Applicant’s method is directed to the selection and retrieval of data from a content server. The fields of invention are not at all similar in this respect. *See In re Clay*, 966 F.2d 656, 23 U.S.P.Q.2d 1058 (Fed. Cir. 1992) (holding that applicant’s claims dealing with a gelled solution filling a tank’s dead volume to prevent loss of stored product while

preventing contamination was not within the same field of invention as a reference disclosing a process for reducing the permeability of natural underground hydrocarbon bearing formations using a gel similar to that of applicant to improve oil production). Additionally, Callway is not reasonably pertinent to the problem with which the Applicant is concerned. No person having ordinary skill in the art would reasonably expect to solve the problem of selective media capturing via a communications device by using a wireless display. For the foregoing reasons, Callway is an improper basis for rejection. As such, all claims rejected under Callway are allowable for at least this reason.

Additionally, the Office Action does not provide any motivation to combine Callway and Henrick. Henrick clearly relates to a system that facilitates the purchase and delivery of audio and video content over the Internet. *See* Henrick, Abstract. More specifically, Henrick downloads audio and video content through the Internet by way of a Web server coordinating and transmitting information to a device other than the user's mobile unit. Henrick, Col. 5, ll. 11-24. Callway, on the other hand, deals with transmitting information from a video source such as a DVD player or cable modem to a wireless display. *See* Callway, Abstract. Not only does Henrick fail to mention any sort of wireless display technology, it also lacks a suggestion or motivation for using infrared communications. In fact, it would be illogical to utilize infrared transmission in the Henrick system since a mobile unit is typically not within an infrared effective range of a Web server. Additionally, there is no suggestion that the wireless display described in Callway requests available content items from a content server. Therefore, there is no motivation in the references themselves to make such a combination. The Office Action states that it would have been obvious to combine the references because infrared requires less power than radio communications. However, the Office Action provides no evidence that infrared consumes less power than radio communications, nor does the Office Action present any evidence of the level of knowledge of one of ordinary skill in the art indicating that such knowledge is within their understanding. Without a motivation to combine Henrick and Callway, claims 6 and 25 are further allowable for this additional reason.

Claims 46, 47, 49, 51, 54-56, 58-59 and 61 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chaddha *et al.* (U.S. Patent No. 6,173,317) (hereinafter “Chaddha”) in view of Henrick. This rejection is respectfully traversed.

Chaddha teaches a method of streaming and displaying a video stream with synchronized annotations over a computer network. The method allows client computers to receive streaming video and annotations synchronized with particular portions of the video. See Abstract. Chaddha teaches that the annotations and video are viewed together, on a single display, to facilitate the annotative aspects of the additional information synchronized to the video. Col. 2, line 62 – Col. 3, line 12. Therefore, the transmission mechanism would involve sending both annotations and video to the same device.

Henrick, on the other hand, explicitly teaches hearing a broadcast song a first device, requesting the song on a second device and downloading the song to a third device. Col. 3, ll. 26-41. Therefore, Henrick teaches three distinctly different devices that are involved in the transmission of audio. Additionally, Henrick provides a system specifically targeted at downloading video or audio and not a video stream with synchronized annotations. There is no motivation or suggestion in either Henrick or Chaddha to combine a radio station song download method with streaming transmissions of synchronized annotated video. As further evidence of a lack of motivation, Henrick teaches using three separate devices to download the requested song whereas the method of Chaddha teaches using only one. It would defeat the purpose of the Chaddha method to transmit the annotations to a separate device than the video stream since annotations are meant to accompany the annotated item (i.e., the video stream). The Office Action’s alleged motivation to combine is superfluous at best, stating that the combination “enhance[s] mobility and avoid[s] unnecessary wiring.” Even if this were true, it is not a motivation to combine, but rather is a result of the combination and thus constitute impermissible hindsight. Therefore, claims 46, 47, 49, 51, 54-56, 58-59 and 61 are allowable because there is no motivation to combine Henrick and Chaddha.

In addition, claims 46, 51, and 56 have been amended to recite, *inter alia*, “the content server identifying data corresponding to a video display image displayed on a device other than the mobile unit at a time when the request is received,” which is neither taught nor suggested by either Henrick or Chaddha.

Claims 50 and 60 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chaddha in view of Henrick and further in view of Wegener. This rejection is respectfully traversed.

As discussed above, there is no motivation to combine Chaddha and Henrick.

Additionally, base claims 46 and 56 recite, *inter alia*, “data corresponding to a video display image displayed on a device other than the mobile unit at a time when the request is received.” Neither Chaddha, Henrick, nor Wegener teaches such a feature. In fact, both Chaddha and Wegener teach receiving data related to a particular video stream or content item on the same device. In Chaddha, the method downloads the annotations to the same video display as the video stream at the synchronization point. Col. 2, ll. 47-67. It would be illogical to download the annotations to any other device since the main purpose of annotations is to accompany the annotated item. In Wegener, a user may request additional portions of the same content that is currently being viewed on the mobile unit. Col. 6, ll. 19-48. Therefore, neither Chaddha nor Wegener teach or suggest data corresponding to a video display image displayed on a device other than the mobile unit at a time when the request is received.

Furthermore, claims 50 and 60 each recite the downloading of data from the mobile unit to a destination computer. Neither Chaddha, Henrick, nor Wegener teach or suggest such a feature.

In addition, claims 50 and 60, dependent on base claims 46 and 56, respectively, are allowable for at least the same reasons as their base claims.

CONCLUSION

It is believed that no extension of time fee is required for this submission. If any extensions of time or additional fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

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By:

A handwritten signature in black ink, appearing to read "Ross A. Dannenberg", is written over a horizontal line.

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